

REMARKS

Claims 1-3 are pending in this application. Claims 1-3 have been amended to better define the inventions. New claims 4-18 are added. The support for the amendments to claims 1-3 and for the new claim can be found at least in page 43, the last line to page 45, line 17. No new matter has been introduced.

The specification has been amended to correct typographical errors and to present the trademarks in the form suggested by the Examiner. Applicants submit that no new matter has been introduced by these amendments. For instance, one skilled in the art would have understood that “Mg” was meant to be “Co” in page 74, line 10 and page 96, line 2 because cobalt acetate tetra hydrate was mentioned in the same sentence.

Specification

The specification has been amended according to the Examiner’s comments in page 2 of the Office Action. The trademarks, BONASORB UA-3901, TINUVIN 326, ADK STAB LA-31, and NOVAPEX, are now capitalized and accompanied by the generic terminology. *See* the first full paragraph on page 24, the second full paragraph on page 26, the paragraph bridging pages 84 and 85, and the second full paragraph on page 86.

Claim Rejections under 35 U.S.C. §112

Applicants respectfully traverse the rejections of claims 1-3 under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-3 have been amended. The phrase “the sample” has been replaced with “the square.” Claims 1-3 are now fully in compliance with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections of claims 1-3 are respectfully requested.

Claim Rejections under 35 U.S.C. §103

Applicants respectfully traverse the obviousness rejection of claim 1 under 35 U.S.C. §103(a) over Ito et al. (US 6,458,437), and in view of Arakawa et al. (US 2003/0071794).

Claim 1 has been amended to include the additional limitation that the claimed heat-shrinkable polyester film is made by a process comprising at least two drawing stages in the maximum shrinkage direction, wherein the first stage of drawing is performed at a first temperature that is from 5°C below T_g to 15°C above T_g and at a first drawing ratio of between 4.4 and 6.0; and wherein the second stage of drawing is performed at a second temperature that is identical to or about 1 to about 5°C lower than the first temperature and at a second drawing ratio of between 1.1 and 1.5.

Neither Ito nor Arakawa teaches or suggests a heat-shrinkable polyester film made by the process as recited in instant claim 1. Although Ito discloses that the film may be further stretched in the machine or transverse direction after biaxial stretching (column 5, lines 55-59), it does not teach or suggest the temperature or stretching ratio for the second drawing stage, as recited in the amended claim 1. Arakawa does not teach or suggest a heat-shrinkable polyester film made by a process comprising at least two drawing stages in the maximum shrinkage direction, let alone the temperature or stretching ratio in either stage. Because Ito and Arakawa, even when taken in combination, fail to teach or suggest all the limitations of the amended claim 1, a *prima facie* case of obviousness has not been established.

The claimed heat-shrinkable polyester film, made by the process according to claim 1, satisfies the Requirement (C) as recited in claim 1. See, e.g., Experiment 1, pages 75-76; Tables 2-5, pages 78-84. Applicants have found, unexpectedly, that the film satisfying the Requirement (C) has a reinforcing effect for a wrapped container. See page 12, line 22 to page 13, line 5. When the Requirement (C) is not satisfied, the reinforcing effect for a container after wrapping and shrinking is not sufficient (page 12, lines 26-30). Neither Ito nor Arakawa teaches or suggests the reinforcing effect achieved by a heat-shrinkable polyester film meeting the Requirement (C) as recited in claim 1.

For at least the foregoing reasons, claim 1 would not have been obvious over Ito, and in view of Arakawa. Withdrawal of the rejection of claim 1 is respectfully requested.

II. Applicants respectfully traverse the obviousness rejection of claim 2 under 35 U.S.C. §103(a) over Ito, and in view of Boseki (JP 2002-331581).

Claim 2 has been amended to recite a heat-shrinkable polyester film that is made by a process comprising at least two drawing stages in the maximum shrinkage direction, wherein the first stage of drawing is performed at a first temperature that is from 5°C below T_g to 15°C above T_g and at a first drawing ratio of between 4.4 and 6.0; and wherein the second stage of drawing is performed at a second temperature that is identical to or about 1 to about 5°C lower than the first temperature and at a second drawing ratio of between 1.1 and 1.5.

As discussed above, Ito does not teach or suggest a heat-shrinkable polyester film made by a process comprising at least two drawing stages in the maximum shrinkage direction, with the temperature or stretching ratio for the second drawing stage recited in the amended claim 2. The deficiency of Ito is not cured by Boseki. Further, Boseki, like Ito, does not recognize the reinforcing effect for a wrapped container achieved by a heat-shrinkable polyester film that satisfies the Requirement (C) as recited in claim 2.

For at least the foregoing reasons, claim 2 would not have been obvious over Ito, and in view of Boseki. Withdrawal of the rejection of claim 2 is respectfully requested.

III. Applicants respectfully traverse the obviousness rejection of claim 3 under 35 U.S.C. §103(a) over Ito, and in view of Hayakawa et al. (WO 02/087853; English equivalent: US 2003/0165658).

Neither Ito nor Hayakawa, alone or in combination, teaches or suggests a heat-shrinkable polyester film made by at least two drawing stages in the maximum shrinkage direction, with the temperatures and drawing ratios as recited in the amended claim 3. Because Ito and Arakawa, even when taken in combination, fail to teach or suggest all the limitations of the amended claim 3, a *prima facie* case of obviousness has not been established. Withdraw of the rejection of claim 3 under 35 U.S.C. 103(a) is respectfully requested.

Double Patenting

Claims 1-3 were rejected on the ground of nonstatutory obviousness-type double patenting as being obvious over claim 1 of U.S. Patent No. 7,279,204 in view of Arakawa, Boseki, and Hayakawa, respectively. Applicants request that the rejections be held in abeyance. Without acquiescence with the rejections, applicants will submit a terminal disclaimer when at least some of the claims are held to be otherwise allowable.

CONCLUSION

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

If the filing of this response is deemed not timely, Applicants petition for an appropriate extension of time.

The Examiner is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

Dated: November 7, 2008

By: King L. Wong
King L. Wong
Reg. No. 37,500

KENYON & KENYON LLP
1500 K Street, N.W., Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201